

The opinion in support of the decision being entered
today was not written for publication and
is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS RIENER and PETER SCHMALLEGGER

Appeal No. 2003-1477
Application No. 09/248,533

ON BRIEF

Before GARRIS, PAK, and PAWLIKOWSKI, Administrative Patent
Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the
examiner to allow claims 4-9 as amended subsequent to the final
rejection.¹ These are all of the claims remaining in the

¹ On page 2 of the answer, the examiner states that the after-final-
rejection amendment filed December 5, 2001 has not been entered (which is
inconsistent with the examiner's subsequent indication that the copy of the
appealed claims in the brief appendix is correct since this copy reflects

(continued...)

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application.

The subject matter on appeal relates to a method of forming modules on a module tape for use in a dual mode data carrier which comprises the steps of mounting a plurality of contact-bound-mode module contact zones on a first side of a carrier layer and depositing a plurality of contactless-mode module contact zones on a second side of the carrier layer by means of a printing method. Further details of this appealed subject matter are set forth in representative independent claim 4 which reads as follows:

4. A method of forming modules on a module tape for use in a dual mode data carrier, each of said modules comprising a chip having a plurality of contact-bound-mode terminals and a plurality of contactless-mode terminals, the method of forming the modules comprising the steps:

providing a carrier layer of an electrically insulating material, the carrier layer having a first side and a second side;

¹(...continued)

entry of the aforementioned amendment). In fact, entry of this amendment was authorized by the examiner in the Advisory Action mailed December 13, 2001. Although this entry authorization has not been clerically processed, it is beyond dispute that the claims officially pending and on appeal in this application are the claims as modified via the December 5, 2001 amendment. It is here appropriate to point out that this amendment, in presenting the amended form of independent claim 4, erroneously used the numeral 1 rather than the numeral 4 (see page 1 of the amendment). It is proper that we ignore this error in our disposition of this appeal (as the examiner seemingly did in authorizing entry of the amendment), and the Examining Corps may choose to do likewise in effectuating amendment entry upon return of this application to Corps jurisdiction.

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mounting a plurality of contact-bound-mode module
contact zones on the first side of the carrier layer;

depositing a plurality of contactless-mode module
contact zones on the second side of the carrier layer
by means of a printing method; and

electrically coupling the contact-bound-mode
terminals of the chip to the contact-bound-mode module
contact zones and electrically coupling the
contactless-mode terminals of the chip to the
contactless-mode module contact zones.

The references set forth below are relied upon by the
examiner in the § 102 and § 103 rejections before us in this
appeal:

Prancz (Prancz '424) 6,095,424 Aug. 01, 2000

Prancz et al. (Prancz '570) WO 97/05570 Feb. 13, 1997

Appellants' Admitted Prior Art (Specification page 1, lines 1-28)

Claims 4-9 are rejected under 35 U.S.C. § 112, second
paragraph, as being indefinite for failing to particularly point
out and distinctly claim the subject matter which the appellants
regard as their invention.

Claims 1-8, "as understood"² (answer, page 3), are rejected

² In making his above-noted prior art rejections, notwithstanding the
presence of his § 112, second paragraph, rejection, the examiner has failed to
proffer claim interpretations upon which these prior art rejections are based
pursuant to the guidelines set forth in the Manual of Patent Examining
Procedure (MPEP) section 2173.06 (8th ed. Rev. 1, Feb. 2003). Instead, the
examiner has improperly categorized the prior-art rejected claims with the
unembellished and uninformative phrase "as understood". This impropriety on

(continued...)

under 35 U.S.C. § 102(b) as being anticipated by Prancz '570 and under 35 U.S.C. § 102(e) as being anticipated by Prancz '424.

Finally, claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over either Prancz '570 or Prancz '424 in view of the admitted prior art (i.e., the prior art described on page 1, lines 20-25, of the subject specification).

On page 3 of the brief, the appellants state, "[f]or the purpose of this appeal [,] Claims 4-9 shall stand or fall together, controlled by independent Claim 4." In light of this statement, we will focus on claim 4, the sole independent claim on appeal, in assessing the merits of the rejections before us.

Rather than reiterate the respective positions advocated by the appellants and by the examiner concerning the afore-noted rejections, we refer to the brief and to the answer³ for a complete exposition thereof.

OPINION

²(...continued)

the examiner's part is harmless in view of our disposition of his § 112, second paragraph, rejection.

³ On page 1 of the answer, the examiner, by inadvertent oversight, indicates that his answer is in response to the brief filed March 4, 2002. The application file record clearly reveals, however, that the answer, in fact, is in response to the corrected brief filed August 12, 2002 which was required by the examiner in his communication mailed June 11, 2002 wherein the March 4, 2002 brief was held to be defective. Particularly because the substantive portions of the original and corrected briefs are identical, the examiner's oversight has no impact on this appeal.

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For the reasons set forth below, we will sustain the examiner's prior art rejections but not his § 112, second paragraph, rejection.

The only exposition offered by the examiner in support of his § 112, second paragraph, rejection appears on page 3 of the answer and reads as follows:

Claim 4 recites [the] limitation: "each of said comprising" in line 2. It is not clear what "said" is in reference to. Also, Claim 9, line 4, the term "carrier" has been misspelling [sic].

Without question, the afore-quoted exposition completely fails to support the examiner's § 112, second paragraph, rejection. The claim 4 criticism is not even accurate in light of the previously discussed amendment filed by the appellants on December 5, 2001. Likewise, the claim 9 criticism is inaccurate since the term "carrier", though misspelled in the claim copy appearing the brief appendix, is correctly spelled in the actual claim.⁴

Under these circumstances, it is apparent that the

⁴ In any event, we do not perceive and the examiner does not explain why a misspelled term would render a claim offensive to the second paragraph of § 112.

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examiner's § 112, second paragraph, rejection of claims 4-9 cannot be sustained.

Concerning the § 102 rejections, it is the appellants' basic position that the respective Figure 23 embodiments of Prancz '570 and Prancz '424 do not include the appealed claim step of "depositing a plurality of contactless-mode module contact zones on the second side of the carrier layer by means of a printing method." As correctly explained by the examiner, however, each of these Figure 23 embodiments includes contacts 47, 48 (which correspond to the here claimed "contact-bound-mode module contact zones") on one side of carrier 28 and contacts 32, 33 connected via channels 57, 58 with contacts 4, 5 (which correspond to the here claimed "contactless-mode module contact zones") on the other side of carrier 28. As for their claimed requirement that the contactless-mode module contact zones be deposited "by means of a printing method", the appellants concede that the Figure 23 contacts 4, 5 are deposited via a screen printing method. Nevertheless, the appellants argue that

[t]he examiner has unduly broadly read the claim 1 limitations of independent claim 4 by equating contactless-mode module contact zones, as claimed, to deeply buried coil contacts of a transmission system that, in fact, is connected to contactless-mode module contact zones through electrically conductive channels formed in many intermediate steps. (Brief, page 6).

We cannot agree.

It is well settled that, during examination proceedings, claims are given their broadest interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Here, the appellants have conceded that contactless-mode contacts 4, 5 of Figure 23 are deposited via a screen printing method. It may be true that such a method is not used to deposit other elements, such as contacts 32, 33 (which along with contacts 4, 5 make up the contactless-mode module contact zones of Figure 23). However, we find nothing and the appellants point to nothing in appealed claim 4 or in their specification disclosure which requires that all elements of the zones in question be deposited by means of a printing method. To the contrary, the originally filed specification expressly discloses that the second conductor layer 23 shown in appellants' drawing, which forms the here claimed contactless-mode module contact zones (e.g., see lines 21-25 on page 4), may be

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manufactured by a copper lamination method (e.g., see lines 13-15 on page 4) rather than a silver paste screen-printing method (e.g., see the paragraph bridging pages 3 and 4) of the type here claimed. In light of this disclosure, the claim 4 interpretation offered by the examiner and discussed above, though broad, is both reasonable and consistent with the appellants' specification. In re Hyatt, 211 F.3d at 1372-73, 54 USPQ2d at 1667-68.

For the above-stated reasons, we will sustain each of the examiner's § 102 rejections of claims 4-8 as being anticipated by Prancz '570 and Prancz '424 respectively.

The § 103 rejection of claim 9 as being unpatentable over either of the Prancz references and further in view of the admitted prior art also will be sustained. Consistent with the earlier mentioned statement on page 3 of the brief regarding claim grouping, the appellants advance no arguments specific to the feature recited in claim 9. In effect, therefore, the rejection of this claim is sustained primarily because it has not been contested with any reasonable specificity.

OTHER ISSUES

Dependent claim 6 recites that the contactless-mode module contact zones of parent independent claim 4 are formed of an electrically conductive material. This material is further defined in dependent claim 7 as a conductive silver paste, consistent with the appellants' specification disclosure. In dependent claim 8, this material is alternatively defined as copper. We find no support in the specification disclosure for this claim 8 feature.

In this regard, the specification clearly teaches depositing contactless-mode module contact zones by means of a printing method as required by independent claim 4 and forming these zones by depositing an electrically conductive material as required by dependent claim 6 and using as this material a conductive silver paste as required by dependent claim 7. However, the specification appears to contain no teaching whatsoever of depositing these zones by means of a printing method wherein the electrically conductive material is copper as required by dependent claim 8. Contrariwise, the appellants in their

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specification repeatedly stress the cost advantage of forming these zones by a printing method using silver paste as opposed to the more expensive prior art method involving copper lamination (e.g., see the paragraph bridging pages 1 and 2, the first full paragraph on page 2 and the first full paragraph on page 6 of the originally filed specification).

Under the circumstances recounted above, in any further prosecution that may occur, the appellants and the examiner should address and resolve whether claim 8 offends the written description requirement and/or the enablement requirement set forth in the first paragraph of 35 U.S.C. § 112.

CONCLUSION

We have sustained each of the examiner's prior art rejections but not his § 112, second paragraph, rejection.

The decision of the examiner is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
BEVERLY A. PAWLIKOWSKI)	
Administrative Patent Judge)	

BRG/vsh

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CORPORATE PATENT COUNSEL
US PHILIPS CORPORATION
580 WHITE PLAINS ROAD
TARRYTOWN, NY 10591